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REMARKS

The Office Action of September 27, 2007 was received and carefully reviewed. Reconsideration and withdrawal of the currently pending rejections are requested for the reasons advanced in detail below.

Claims 1-2 and 4-6 were pending prior to the instant amendment. By this amendment, claims 1 and 5 are amended. Consequently, claims 1-2 and 4-6 are currently pending in the instant application.

Claims 1, 2 and 4 were rejected under 35 U.S.C. §102(b) as anticipated by or, in the alternative, under 35 U.S.C. §103(a) as obvious over Uchida et al. (U.S. Patent No. 6,468,365). Claim 5 was rejected under 35 U.S.C. §102(b) as anticipated by or, in the alternative, under 35 U.S.C. §103(a) as obvious over Uchida et al. Uchida et al., however, fails to render the claimed invention unpatentable. Each of the claims recite a specific combination of features that distinguishes the invention from the prior art in different ways. For example, independent claims 1 and 5 have been amended to recite a combination that includes, among other things:

"... 0.85 mass% to 0.96 mass % of B ..."

At the very least, Uchida et al. fails to disclose or suggest any of these exemplary features recited in amended independent claims 1 and 5.

The present invention recites the upper limit of boron (B) concentration is less than the boron concentration of the magnet disclosed in Uchida et al. (Support for the amended claimed ranges is provided, at least, in Applicants' originally filed specification on page 19 and in FIGS. 1 and 7.) According to the present invention, as the B concentration is lowered,

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a soft magnetic R2Fe17 phase is easily formed in the grain boundary phase, and therefore, the coercivity is decreased significantly. It is apparent, from the disclosure of the present application, that the coercivity will decrease if the B concentration is set in the claimed range without the addition of Ga. The present application shows that the addition of Ga allows the B concentration to be less than or equal to 0.96 mass %. According to the present invention, even though the B concentration is reduced, a high-coercivity sintered magnet, including substantially no B-rich phases (R1.1Fe4B4), is still provided with the production of a minimized soft magnetic phase.

Turning to the cited prior art, Uchida et al. fails to teach or suggest that the B concentration can be less than 0.97 mass %. Thus, one of ordinary skill in the art would not be led to perceive that the coercivity would decrease if the B concentration is set less than 0.97 mass %. Therefore, the claimed invention is not obvious from Uchida '365.

For anticipation under 35 U.S.C. § 102, the reference must teach every aspect of the claimed invention either explicitly or impliedly. Any feature not directly taught must be inherently present (M.P.E.P. 706.02). Since each and every element, as set forth in the claims are not found either expressly or inherently described as required by the M.P.E.P., Uchida et al. cannot be said to anticipate the invention as claimed. Hence, withdrawal of the rejection is respectfully requested.

In accordance with the M.P.E.P. § 2143.03, to establish a *prima facie* case of obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 409 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 196 (CCPA 1970). Therefore, it is respectfully submitted that Uchida et al., taken alone or in any proper combination, does not disclose or

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fairly suggest the subject matter as recited in claims 1 and 5. Hence, withdrawal of the rejection is respectfully requested.

Each of the dependent claims depend from one of independent claims 1 or 5 and are patentable over the cited prior art for at least the same reasons as set forth above with respect to claims 1 and 5.

In addition, each of the dependent claims also recite combinations that are separately patentable.

Claim 6 was rejected under 35 U.S.C. §103(a) as being unpatentable over Uchida et al., as applied to claim 5, and further in view of Li (U.S. 6,527,874). However, claim 6 relies upon independent claim 5 which recites a specific combination of features that distinguishes the invention from Uchida et al. in different ways, as outlined above. Li fails to cure the deficiencies of Uchida et al. in that, *inter alia*, Li fails to disclose or fairly suggest the claimed B range as recited in claim 5. Thus, at the very least, the applied references fail to disclose or suggest the exemplary features recited in independent claim 5.

Since all of the claim limitations are not taught or suggested by the prior art to establish a *prima facie* case of obviousness, it is respectfully submitted that neither Uchida et al. nor Li, taken alone or in any proper combination, disclose or suggest the subject matter as recited in claim 5. Claim 6 depends from independent claim 5 and is patentable over the cited prior art for at least the same reasons as set forth above with respect to claims 5. Hence, withdrawal of the rejection is respectfully requested.

In addition, claim 6 also recites combinations that are separately patentable.

In view of the foregoing remarks, this claimed invention, as amended, is not rendered obvious in view of the prior art references cited against this application. Applicant therefore request the entry of this response, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

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In discussing the specification, claims, and drawings in this response, it is to be understood that Applicant in no way intends to limit the scope of the claims to any exemplary embodiments described in the specification and/or shown in the drawings. Rather, Applicant is entitled to have the claims interpreted broadly, to the maximum extent permitted by statute, regulation, and applicable case law.

Should the Examiner believe that a telephone conference would expedite issuance of the application, the Examiner is respectfully invited to telephone the undersigned patent agent at (202) 585-8316.

Respectfully submitted,

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